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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,560	06/27/2003	Paul-Andre Roland Savoie	12971-1US-1-RE	5456

20988 7590 03/31/2005
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MONTREAL, QC H3A2Y3
CANADA

EXAMINER

BEHNCKE, CHRISTINE M

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,560

Applicant(s)

SAVOIE, PAUL-ANDRE ROLAND

Examiner

Christine M. Behncke

Art Unit

3661

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____
- 7) ☐ Paper No(s)/Mail Date _____

DETAILED ACTION

1. This office action is in response to the reissue application filed 20 April 2001, in which claims 1-31 were presented for examination.

Reissue Applications

2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The declaration failed to fully identify at least one error being relied upon as a basis for the reissue and that it is indeed an appropriate error for reissue (37 CFR 1.175 (a)(1)). Specific changes or amendments to the claims must be identified. If new claims are presented, their differences from the original claims must be pointed out.

Claims 1-31 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claim Rejections - 35 USC § 251

4. Claims 11-31 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is as follows: The claimed subject matter originally filed was a method and system of locating a stolen vehicle provided with a locating cellular transceiver. The original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application by that the original specification supported that the claimed transceiver was restricted to being located in a vehicle by being directly connected to the vehicle's power source, such as a car battery (Column 5, lines 7-11), and the antenna to be "laid out inside the vehicle" (Column 5, lines 3-7). According to the MPEP § 1412.01, the proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the original patent." As previously stated, the only power source for the cellular transceiver disclosed by the applicant in the original specification was the car battery with a possible back-up battery. However the amended claims 11 and 22 contain methods of locating information concerning a cellular transceiver that is silent about the power supply of said transceiver. The removal of the vehicle limitation broadens the scope of the claims to incorporate cellular transceivers located on persons, inanimate objects, animals, and etc. The Examiner contends that the implementation of the vehicle locator

cellular transceiver to a smaller mobile unit for a person or animal is patentably different, and was not possessed by the applicant at the time of the original filing. The Examiner further refers to the currently held US Patent No. 6,498,565 (further referred to as patent '565) filed February 6, 2001 that concerns a method and a system for tracking an object, person or animal that is provided with a wireless transceiver. Patent '565 shares a common inventor with the application, André Eric Boulay, and has a common assignee, Boomerang Tracking, Inc. As admitted by the applicants of patent '565, the invention is an improvement over U.S. Patent No. 5,895,436, and while uses a similar two-way tracking system but has adapted that patented technology to apply to locating a variety of objects, persons, or animals (Column 1, lines 12-41). One significant adaptation is the power source of the transceiver, power levels were specifically disclosed to vary between acceptable power levels of a standard cellular telephone (Column 3, lines 32-35). In light of original specification and the referred patent the Examiner contends that the subject matter extending the claimed tracking technology for a stolen vehicle was not known or put to practice at the time of the originally filed specification and therefore lacks intent to claim the subject matter currently presented in the reissue application.

Conclusion

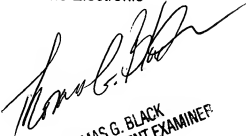
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine M. Behncke whose telephone number is (703)

305-0589. The examiner can normally be reached on Monday - Friday 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on (703) 305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

03-22-2005


THOMAS G. BLACK
SUPERVISORY PATENT EXAMINER
GROUP 3600